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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/801,187

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Kazuyuki Yokokawa

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

06/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/801,187	Applicant(s) YOKOKAWA, KAZUYUKI	
	Examiner Victor S. Chang	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 181-186, 188-194, 197-212, 214-234, 236-254, 256-264 and 269-272 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 181-186, 188-194, 197-212, 214-234, 236-254, 256-264 and 269-272 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Applicants' amendments and remarks filed on 4/11/2008 have been entered. Claims 201, 204, 237, 256, 269 and 270 have been amended. Claim 271 is identified as "(currently amended)", however no markup of amendment is found, presumably the amendment relates to the addition of punctuation. New claim 272 has been entered. Claims 181-186, 188-194, 197-212, 214-234, 236-254, 256-264 and 269-272 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 181-186, 188-194, 197-212, 214-234, 236-264 and 269-271 are rejected under 35 U.S.C. 102(e) as being anticipated by Mihara et al. [US 6380132].

In addition to the reasons set forth in section 2 of Office action mailed 1/28/2008, in response to the amendments, the grounds of rejections are maintained as set forth below:

For claims 201 and 204, the term "multilayered" has been amended as "multi-layered". For claims 237 and 256, the term "bottommost" has been amended as "bottom-most". For claims 269-271, the amendments relate to clarifying punctuations. Since the amendments do not change the scope of the claimed invention, the grounds of rejections are maintained.

For new claim 272, since all the limitations are within the scope of prior claims (e.g., claims 191, 192 and 182), claim 272 is rejected for the same reasons.

Response to Arguments

5. Pointing to the Final action mailed 1/28/2008, referring to the use limitations, applicant argues at Remarks page 15 that

“No explanation was provided in Examiner Ahmad's rejections as to why these claimed features do not structurally limit the claims. For example, if a sheet structure splits when bent that is certainly a structural limitation or feature of that sheet structure, and is to be distinguished from a sheet structure which does not split when bent. Whether the sheet structure splits when bent is dependent on a number of structural features of the sheet structure, as would be understood by those skilled in the art, and as explained in the section below relative to Dr. Ugolick's Declaration. Applicant continues to contend that the claimed features are not "intended use, do-not-affect-the-structure limitations."”

However, a review of said Final action shows that the prior examiner has reasoned that “the Examiner also involved considering all limitations in the claims at issue and the phrases that are not found to be of positive limitations were not given patentable weight because said phrases are directed to potential uses of said claimed product. Further, contrary to applicant's position, the phrases at issue are directed to language as to what it will do and not what it does.” See Final action, pages 3-4. The examiner maintains that since statements of intended use do not serve to distinguish structure over the prior art, they have not been given any patentable weight. More particularly, since Mihara does teach that portions of the multilayered sheet is separable, as illustrated in Figs. 9 and 10, it is unseen how the use step of bending renders the claimed structure distinct, and necessarily produce a different resultant separated portion. Applicant is advised to distinctly claim structure features of the intended scope.

Pointing to Dr. Ugolick's declaration, applicant argues at page 16 that

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“Dr. Ugolick in his Declaration analyzed each of the phrases at issue above, and he concluded that each was a structural limitation. He further explained in detail why they were structural limitations because they "depend on many if not all of at least the following structural features, as would be apparent to those skilled in the art: below including one or more of the following: (a) depth of the cut line; (b) width of the cut line; (c) the material of the breakable layer; (d) the properties of the paper layer; (e) the thickness of the breakable layer; (f) if any adhesive is used, the properties of the adhesive; and (g) the depth of the penetration, if any, of the cut line into the breakable layer.””

However, Dr. Ugolick's analysis clearly admitted that the method of use languages “depend on many if not all of at least the following structural features.” In other words, the use limitations would fail to distinctly claim the intended structural features of the claimed invention, because it would be indefinite to determine what structural features are included in the intended scope.

Applicant's arguments at pages 17-26 have been carefully considered, and the examiner agrees that the clauses of "adapted to", "adapted for", "wherein" and "whereby" must be carefully considered, and given patentable weight when they are relevant to the claimed invention.

However, in the instant invention, since the use languages fail to distinctly claim intended structural features, as evidenced by Dr. Ugolick's declaration, the examiner maintains that since statements of intended use do not serve to distinguish structure over the prior art, they have not been given any patentable weight.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794